UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,338	03/01/2002	John p. Ruckart	010417	4121

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EXAMINER
HASHEM, LISA

ART UNIT	PAPER NUMBER
2614	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/086,338	RUCKART, JOHN P.
	Examiner	Art Unit	
	Lisa Hashem	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>9-15-06</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>6-22</u> is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>6-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All   b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
  Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 6-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter '...at least one of a schedule including at least one time period during which the incoming call is placed on hold, and a list including at least one potential calling party from whom incoming calls are placed on hold...' which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Section 0047 in the instant application discloses '...a predetermined time period during which the hold function is enabled...'. There is not mention of a schedule including at least one time period.

Section 0048 in the instant application discloses '...The user may enable the hold function by, for example, using DTMF codes (e.g. dialing a star (*) code), telephoning an integrated voice response system (IVRS) and enabling the function and defining its parameters, enabling the function and defining its parameters via a computer web interface, or by communicating the times for the hold function to be active by interfacing with a scheduling program such as, for example, Microsoft Outlook...'. The scheduling program that is mentioned in the specification does not mention anything about a schedule including a time period. One of ordinary skill in the art acknowledges that the scheduling program, Microsoft Outlook, is an email application.

There is no mention in the instant application of '...a list including at least one potential

calling party from whom incoming calls are placed on hold...'. Appropriate action is required.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Claims 6-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. It is not clear what the term 'on hold' is defined as in the claims. This term has

not been clearly defined in the specification. Examiner interprets this term to mean one of:

establishing a call connection on a line, the talk path is established (not necessarily with the

calling party), and a calling party is waiting on the line to communicate with a called party. The

preamble states that an incoming call is placed on hold prior to being answered by a called party

but the body of the claim states that the incoming call is placed on hold if the call corresponds to

the one or more parameters.

4.   Claims 6-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. It is not clear what the term 'schedule' is defined as in the claims. This term has

not been clearly defined in the specification. Examiner interprets this term to mean a procedure,

preference, or plan to perform something.

5.   Claim 19 recites the limitation "the telecommunications device". There is insufficient

antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 6-13 and 17-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated

by U.S. Patent No. 5,652,789 by Miner et al, hereinafter Miner.

Regarding claim 6, Miner discloses a method of placing an incoming call to a

telecommunications device (col. 20, lines 40-50; col. 29, lines 17-21; col. 30, lines 51-60; col.

32, lines 1-47) from a calling party on hold (e.g. waiting) prior to being answered by a called

party, the method comprising:

receiving one or more parameters of a hold function,

wherein the parameters include at least one of a schedule (e.g. preference, procedure) including

at least one time period (e.g. an existing call being handled) during which the incoming call is

placed on hold (e.g. waiting on the line for the called party when the called party will accept

interruptions) (col. 37, lines 38-56), and

a list (e.g. calling party's contact list) including at least one potential calling party from whom

incoming calls are placed on hold (e.g. waiting on the line for the called party) (col. 32, line 65 –

col. 33, line 54);

automatically answering the call (e.g. the call is waiting and the server is checking on the status

of the called party; the call is not routed to voicemail at this point or disconnected; the talk path

is still established) if the call corresponds to the one or more parameters of the hold function and

placing the call on hold (e.g. not disconnecting the call; stored in queue) (col. 32, lines 54-64;

col. 34, lines 20-33; Fig. 24A: 500, 504, 516, 518, 522; col. 37, line 38-67);

playing a message to the called party that the call has been placed on hold (col. 34, line 60 – col.

36, line 49; col. 38, lines 1-14; Figs. 26 and 27) and

connecting the called party to the calling party when the called party answers the call (col. 36,

lines 44-51; Fig. 26: 614, 622; col. 38, lines 27-29; Fig. 27: 640, 644).

Regarding claim 7, the method of claim 6, wherein Miner further discloses determining

whether the called party has enabled a hold function (col. 32, lines 54-64; col. 33, lines 14-54;

col. 34, lines 60-65; col. 37, line 38 – col. 39, line 3).

Regarding claim 8, the method of claim 6, wherein Miner further discloses determining

whether the called party has pressed a button on the telecommunications device to enable a hold

function (col. 37, line 54 – col. 38, line 3).

Regarding claim 9, the method of claim 6, wherein Miner further discloses means for

alerting the called party of the incoming call (col. 36, lines 44-49; col. 38, lines 1-26).

Regarding claim 10, the method of claim 6, wherein Miner further discloses connecting

the calling party to a voicemail system when the called party does not answer the call within a

predetermined time period (col. 38, lines 15-26).

Regarding claim 11, the method of claim 6, wherein Miner further discloses playing a

message to the calling party includes playing a message that is resident on a services node (e.g. a

virtual machine) of a telecommunications network (Figs. 3 and 5) (col. 20, lines 40-50; col. 38,

lines 15-26).

Regarding claim 12, the method of claim 6, wherein Miner further discloses playing a

message to the calling party includes playing a pre-recorded message stored in a memory device

resident on the telecommunications device (e.g. a virtual machine) (col. 20, lines 40-50; col. 38,

lines 15-26).

Regarding claim 13, the method of claim 6, wherein Miner further discloses connecting

the call to a voicemail system when the called party presses a button on the telecommunications

device (col. 36, lines 47-60).

Regarding claim 21, the method of claim 6, wherein Miner further discloses the receiving

one or more parameters of the hold function is performed via a web interface (col. 10, line 51 –

col. 11, line 3; col. 11, lines 51-63; col. 16, lines 47-60; col. 17, lines 31-59; col. 19, lines 53-61;

col. 33, lines 29-48; col. 37, lines 54-63).

Regarding claim 17, Miner discloses an apparatus (col. 20, lines 40-50; col. 29, lines 17-

21; col. 30, lines 51-60; col. 32, lines 1-47), comprising:

means for receiving one or more parameters of a hold function,

wherein said parameters include at least a schedule (e.g. preference, procedure) including at least

one time period (e.g. an existing call being handled) during which an incoming call is placed on

hold (e.g. waiting on the line for the called party when the called party will accept interruptions)

(col. 37, lines 38-56), and

a list (e.g. calling party's contact list) including at least one potential calling party from whom

incoming calls are placed on hold (e.g. waiting on the line for the called party) (col. 32, line 65 –

col. 33, line 54);

means for automatically answering a call placed by a calling party to a called party (e.g. the call

is waiting and the server is checking on the status of the called party; the call is not routed to

voicemail at this point or disconnected; the talk path is still established),

if the call corresponds to the one or more parameters and placing the call on hold (e.g. not

disconnecting the call; stored in queue) (col. 32, lines 54-64; col. 34, lines 20-33; Fig. 24A: 500,

504, 516, 518, 522; col. 37, line 38-67);

means for playing a message to the calling party that the call has been placed on hold (col. 34,

line 60 – col. 36, line 49; col. 38, lines 1-14; Figs. 26 and 27); and

means for connecting the called party to the calling party when the called party answers the call

(col. 36, lines 44-51; Fig. 26: 614, 622; col. 38, lines 27-29; Fig. 27: 640, 644).

Regarding claim 18, the apparatus of claim 17, wherein Miner further discloses means for

determining whether the called party has enabled a hold function (col. 32, lines 54-64; col. 33,

lines 14-54; col. 34, lines 60-65; col. 37, line 38 – col. 39, line 3).

Regarding claim 19, the apparatus of claim 17, wherein Miner further discloses means for

determining whether the called party has pressed a button on the telecommunications device to

enable a hold function (col. 36, lines 47-60).

Regarding claim 20, the apparatus of claim 17, wherein Miner further discloses means for

alerting the called party of the incoming call (col. 36, lines 44-49; col. 38, lines 1-26).

Regarding claim 22, the apparatus of claim 17, wherein Miner further discloses the

means for receiving one or more parameters of the hold function receives the one or more

parameters via a web interface (col. 10, line 51 – col. 11, line 3; col. 11, lines 51-63; col. 16,

lines 47-60; col. 17, lines 31-59; col. 19, lines 53-61; col. 33, lines 29-48; col. 37, lines 54-63).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

9.   Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okun in

view of Dutta.

Regarding claim 14, Okun discloses a telecommunications system (see Figure 1a; section

0013, lines 1-8), comprising a home location register (Figure 1A, 110) for storing a profile of a

user of a telecommunications device (Figure 1A, 126), wherein the profile includes an indication

of whether the user is a subscriber to an incoming call hold service implemented by the

telecommunications system (e.g. a subscriber profile indicates determining whether a text or

voice message is preferred for a calling party in order to send a message to a calling party that is

on hold) (section 0014, lines 1-6; section 0036, lines 1-8; section 0039, line 1 – section 0040,

line 11; section 0044, lines 1-14; section 0077, lines 1-12);

a services node or serving MSC (Figure 1A, 118) for:

determining whether an incoming call placed to the telecommunications device by a calling party

should be placed on hold prior to the call being answered by the user of the telecommunications

device according to the incoming call hold service; placing the incoming call on hold prior to the

call being answered; playing a message to the calling party that the call has been placed on hold

(section 0054, line 1 – section 0057, line 13); and connecting the telecommunications device to

the calling party if the user of the telecommunications device answers the incoming call (section

0058, line 1 – section 0063, line 10); and a mobile switching center or originating MSC (Figure

1A, 102) for facilitating communication between the telecommunications device, the services

node, and the home location register (section 0054, lines 5-12).

Okun clearly discloses determining whether an incoming call should be placed on hold

prior to being answered. However, Okun does not disclose the determining based on at least one

of a schedule including at least one time period during which the incoming call is placed on hold

and a list including at least one potential calling party from whom incoming calls are placed on

hold.

Dutta discloses a telecommunications system comprising:

a services node or Bluetooth server (col. 5, line 1 – col. 6, line 13; Figs. 5 and 6) for:

determining whether an incoming call placed to the telecommunications device by a calling party

should be placed on hold prior to the call being answered by the user of the telecommunications

device according to the incoming call hold service,

the determining based on at least one of a schedule including at least one time period during

which the incoming call is placed on hold (col. 6, lines 2-13), and

a list including at least one potential calling party from whom incoming calls are placed on hold;

placing the incoming call on hold prior to the call being answered (col. 5, lines 7-14; col. 5, lines

60-67);

playing a message to the calling party that the call has been placed on hold; and

connecting the telecommunications device to the calling party if the user of the

telecommunications device answers the incoming call (col. 5, line 60 - col. 6, line 2).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the telecommunication system of Okun to include the determining based on at least one of a schedule including at least one time period during which the incoming call is placed on hold and a list including at least one potential calling party from whom incoming calls are placed on hold as taught by Dutta. One of ordinary skill in the art would have been lead to make such a modification in a service node to include parameters under which the incoming hold service will be automatically implemented which are predefined. The parameters including a schedule of time periods and a list of potential calling parties.

Regarding claim 15, the system of claim 14 mentioned above, wherein Okun further discloses the services node includes an enunciator or IVR (section 0057, lines 5-9; section 0061, lines 10-14).

Regarding claim 16, the system of claim 15 mentioned above, wherein Okun further discloses the enunciator is for playing a message to a calling party when a call is placed on hold (section 0057, lines 5-9; section 0061, line 10 – section 0062, line 10).

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

11.   Any response to this action should be mailed to:

<div align="center">

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

</div>

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

12.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The

examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or

relating to the status of this application or proceeding should be directed to the Group

receptionist whose telephone number is (571) 272-2600.

13.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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December 20, 2006

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600